REMARKS

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of November 11, 2003. Reexamination and reconsideration are respectfully requested.

The Office Action

Claims 1-20 were presented for examination.

Claims 1-8 and 19 stand rejected as being anticipated by Levine et al. ('493).

Claims 10-17 stand rejected under a combination of Levine et al. and Covington ('193).

Claims 9, 18 and 20 stand rejected as being unpatentable over a combination of Levine in view of APA.

Independent Claims 1, 10 and 19 and Their Dependant Claims are Distinguished from the Cited Art

Rejection of claims 1 and 19 are based solely on the teaching of Levine et al., whereas claim 10 is refused based on a combination of Levine et al. and Covington.

With initial attention to claim 1, it is argued in the Office Action that the step of "detecting the annotation added to the scanned document" is taught in column 3, lines 25-58 of Levine.

Applicant respectfully traverses the interpretation that the above-cited portion of Levine '439 teaches a "detecting" of an annotation. Rather, this section teaches a concept of entering an annotation session view, but there is no teaching of detecting added annotations as set forth in claim 1. Rather, the user makes a choice to enter an annotation session view, where annotations may be added to a document, but there is no teaching or and detecting any added annotations. This patent presents a completely different concept than what is set forth in claim 1.

To emphasize these distinctions, additional language has been added to emphasize that the method will decode the detected annotation and then examine the content of the decoded annotation (*e.g.*, see Figure 5, step 46), as part of the method for carrying out the intent (*i.e.*, content) of the annotations. Due to the distinctly different concepts of Levine '439, this patent has no teaching or suggestion of these matters.

Additionally, column 5, lines 22-44 of Levine are cited as teaching the

7

concept claimed in claim 1 of "determining an action to be undertaken with reference to the document, based on the annotation; and performing the action required by the annotation."

This section of Levine teaches that during an annotation session, a pop-up menu may be displayed to provide a limited number of operational actions that a user may select. However, these actions are not related to a particular annotation. Therefore, they cannot be said to be "based on the annotation." They are simply provided during an annotation session. In fact, it is noted that selection of various ones of the options will end an annotation session, and the other options will provide the user with a new piece of paper on which new annotations may be made. However, the actions are not based on the annotation, they are based on user selection.

Claim 1 has been amended to clarify certain concepts, where these additions are not intended to limit the claims, but to provide a better understanding to the Examiner. For the above reasons, the concepts of claim 1 are not taught or fairly suggested.

Turning attention to claim 2, the system automatically performs the action required by the annotation without user intervention. As noted above, the pop-up menu clearly includes the requirements of user intervention due to the selection. Therefore, in addition to the distinction that Levine '439, column 5, lines 22-44 do not cause an action to be undertaken "with reference to the document based on the annotation", this section also shows that there is no automatic performing of any action "required by the annotation without user intervention" as set forth in claim 2.

This lack of requiring user intervention is described in the application as set out below, by way of a brief review:

> To further describe the concepts of the present invention, the following example is provided. During a plane flight, a user "Bob" may be catching up on his reading using a portable document reader, which has been loaded with documents awaiting his attention. He reads a background report regarding a competing product, and notes in the margin of the document, "send a copy to David." Next Bob reads a budget request for a new piece of office equipment and notes "status: approved" across the top. Finally, he reads a competitive analysis of the product development process at other companies, and notes, "file with process planning" in the margins. He makes the

annotations using his standard mark-up tool, i.e. stylus, pen, keyboard, or other known device.

When Bob returns to his office, he may place his portable document reader in a docking station where the files are checked into his document management system. The active annotation activation mechanism **36** scans the documents and notices that they have been annotated. It reads the annotations, and performs the actions required. Particularly, a copy of the background article will be sent to David as an e-mail attachment; a workflow system is updated to reflect the fact that the equipment request has been approved, and generates a purchase order; and the list of documents related to the new process planning activity is updated with the competitive analysis, causing other interested parties to receive an e-mail notification. ·

Thus, the consequences of the annotations which required further activity did not require human intervention once the information had been uploaded into the document management system. Rather, annotation activation mechanism 36 which is aware of both the nature of the annotation content, and other applications in the document management system whose behavior needs to be coordinated, is capable of providing this active link.

Applicant also traverses the Examiner's interpretation of the actions and design of the active annotation mechanism of claim 2. It is noted that the active annotation mechanism can interpret annotations, and thereafter provide active processes to carry out the requirements of the annotation. These are not concepts equivalent to those cited as being relevant in the stated sections of Levine. For the foregoing reasons, it is also submitted claim 2 is not taught or fairly suggested.

With regard to dependent claims 3-9, applicant notes these claims depend from and further recite aspects of the now-distinguished claim 1, they are also distinguished, where the added amendments are not considered limiting, but rather explanatory, as the concept of the content of the annotations is already found therein.

Turning to independent claim 19, similar arguments as presented with regard to claim 1 are equally applicable. Therefore, it is considered claim 19 is also distinguished.

Similarly, the distinguishing characteristics recited in connection with claim 1 are also applicable to claim 10. Levine does not teach or fairly suggest any concept related to creating an executable code to detect the update data where the update

data are annotations requiring an action be undertaken. Further, there is no teaching or suggestion of the active property concept which performs the actions once the annotations and their meanings are detected. Rather, again, the operation of Levine simply allows a user to actively enter an annotation session, but does not discuss or suggest having the content of the annotation carried out. The areas pointed to by the Examiner simply permit the user to select, from a variety of pop-up menus, certain actions which may be taken while in an annotation session. However, these are in no way tied to any actions related to the content of the annotations. The user may act on an annotation (*i.e.*, erase notes) or may request a "playback" to display a time sequence of the addition of the annotations, but, again, the content of the annotations (*i.e.*, send e-mail to Joe) is not taught or fairly considered anywhere within Levine '439.

With additional attention to the rejection of claim 10, and the application of Covington et al. '193, applicant respectfully traverses this reference as teaching the assigning of a triggering event to a property as set forth in the language of claim 10.

Particularly, the Examiner points to column 2, lines 42-59. However, it is clearly shown that Covington et al. is directed to a generation of a multi-media event, and not a handwritten annotation system such as the present application. While the word "trigger" and "annotation" are used within this patent, they are clearly directed to concepts other than that of the present application. For example, the use of "annotation" in this context is as an annotation sequence which may be annotated. However, what is being discussed here has nothing to do with the handwritten annotations on an electronic document, where the meaning or content of the handwritten annotations are carried out.

For the foregoing reasons, it is respectfully submitted claim 10 is also not taught or fairly suggested by the cited art.

It is noted by applicant that in the Abstract there is a discussion of the system interpreting certain images as specified commands for a data processor to retrieve, manipulate and transmit data in response to the specified commands. However, this concept is more particularly defined, for example, in column 46 and in relation to Figure 14 where it is noted communication is initiated by a specially designed instruction page. This is not a requirement of the present application, and does not correspond to annotations added and recited by the present claims.

In view of the foregoing, it is respectfully submitted all claims as they now are

presented are distinguished over the cited art.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-20) are now in condition for allowance. An early notice to that effect is therefore earnestly solicited.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Mark S. Svat, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

2/10/04

Date

Mark S. Svat
Reg. No. 34,261
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

N:\XERZ\200299\KMF0003412V001.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on 2-10-04

(SIGNATURE)

KAREN FORSYTH

12